

**REMARKS**

At the time of the Office Action dated February 8, 2007, claims 1-24 were pending and rejected in this application.

On page 2 of the Office Action, the Examiner asserted that the title of the invention was not descriptive. In response, the Title has been changed to "INTELLIGENT MAIL GATEWAY," as suggested by the Examiner.

**CLAIMS 1-24 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112**

On page two of the Office Action, the Examiner identified a perceived informality generating an antecedent basis issue. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. As stated in M.P.E.P. § 2173.02:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,<sup>1</sup> "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at

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<sup>1</sup> 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

construction must a court declare it indefinite." The Examiner, however, has not met this burden.

The Examiner identified "said manager" in claim 1, line 6 and asserted that "[t]here is insufficient basis for this limitation in the claim." This assertion, however, is incorrect. Claim 1, line 5 clearly recites "a notification manager." Thus, antecedent basis exists for "said manager" in line 6 of claim 1. Similarly, although the Examiner identified "said messages" in claim 1, line 6 and asserted that "[t]here is insufficient basis for this limitation in the claim," this assertion is also incorrect. Claim 1, line 2 clearly recites "received messages." Thus, antecedent basis exists for "said messages" in line 6 of claim 1.

Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claim 1, particularly when reasonably interpreted in light of the written description of the specification.<sup>2</sup> Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1-24 under the second paragraph of 35 U.S.C. § 112 has been overcome and, hence, Applicants respectfully solicit withdrawal thereof.

**CLAIMS 1, 4-6, AND 15-16 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION  
BASED UPON SPEAR, U.S. PATENT PUBLICATION NO. 2003/0149726**

On page 3 of the Office Action, the Examiner asserted that Spear discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

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<sup>2</sup> In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Independent claim 1 recites, in part, the following limitations:

a notification manager coupled both to the gateway and said message store, said manager having a configuration for notifying selected ones of said senders when delivery to said intended recipients has become impaired.

Similarly, independent claims 5 and 15 recite, in part, the following limitations:

forwarding a notification of said impairment to said identified senders.

To teach these limitations, the Examiner relied upon lines 11-12 of paragraph [0030] within Spear. For ease of reference, lines 9-12 of paragraph [0030] is reproduced below:

Emails that do not satisfy the prescribed criteria in order to be normally processed may be discarded, stored, or sent back to the original sender (recognizing that the address the sender provided probably is fictitious).

As apparent from this teaching, Spear does not teach forwarding a notification of impairment to deliver a message to a sender of the message. Instead, Spear teaches that the message is merely sent back to the original sender. Absent from Spear is an explicit teaching that the sending an e-mail back to the original sender constitutes a notice that delivery to the intended recipient has become impaired.

Moreover, the Examiner cannot rely upon the doctrine of inherency to disclose this feature. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.<sup>3</sup> To establish inherency, the extrinsic evidence must make clear that the missing function must necessarily be present in the thing described in the reference, and

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<sup>3</sup> In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

that the necessity of the feature's presence would be so recognized by persons of ordinary skill.<sup>4</sup>

This burden has not been met. For example, receipt, by the sender, of an e-mail does not necessarily constitute a notification that delivery to the intended recipient has become impaired since delivery could have still been performed.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1, 4-6, and 15-16 under 35 U.S.C. § 102 for anticipation based upon Spear is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 7-8 AND 17-18 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SPEAR IN VIEW OF SHUSTER, U.S. PATENT PUBLICATION NO. 2002/0023135**

On pages 4 and 5 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Shuster to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claims 7, 17 and 8, 18 respectively recite the claimed "detecting an impairment" includes concept of consulting/probing for information regarding the claimed "said respective servers." In the statement of the rejection, the Examiner referred to lines 17-22 of paragraph [0039] within Shuster to teach these limitations. For ease of reference, the Examiner's cited passage is reproduced below:

Then, the destination mail server would obtain the delivery code list belonging to the root address, determine whether the message address contained a valid delivery code, and if so, place the message in the addressee's inbox folder in a subdirectory (folder) belonging to the corresponding delivery code.

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<sup>4</sup> Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

At the outset, Applicants note that the Examiner's cited passage is not relevant to the limitations at issue. Shuster does not teach "consulting a data store of state information for selected ones of said respective mail servers" (i.e., claims 7 and 17) or "probing selected ones of said respective mail servers to detect said impairment (i.e., claims 8 and 18). Instead, Shuster teaches checking whether a message address contains a valid delivery code, which is not related to the statement information and/or impairment of the claimed respective servers.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 7-8 and 17-18 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Shuster is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 9 AND 19 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED  
UPON SPEAR IN VIEW OF EGUCHI, U.S. PATENT PUBLICATION NO. 2001/0040694**

On page 5 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Eguchi to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

It has been repeatedly held that one having ordinary skill in the art cannot be presumed realistically motivated to modify a reference in the manner inconsistent with the disclosed objectives.<sup>5</sup> The Examiner's proposed modification, however, would achieve exactly that. In this regard reference is made to paragraph [0018] of Spear, which is reproduced below:

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<sup>5</sup> In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Schulpen, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

Accordingly, it has been desired for a mail server effectively to reject junk email, or spam, prior to receipt by an email account user, to do so in real time or with only a negligible delay, and to do so with a minimum of network resources. In addition, it is preferred that this could be achieved while not precluding the use of other types of email filters.

Thus, a clearly stated purpose of Spear is to prevent delivery of junk e-mail prior to receipt by an e-mail account user. The Examiner's proposed modification, however, would defeat this stated objective by "attempting to transmit said message," which is the alleged modification based upon Eguchi. Thus, one having ordinary skill in the art would not have been led to modify Spear in the manner suggested by the Examiner.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 9 and 19 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Eguchi is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 3, 10-11, AND 20-21 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS  
BASED UPON SPEAR IN VIEW OF PEARSON ET AL., U.S. PATENT PUBLICATION NO.  
2005/0235360**

On page 6 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Eguchi to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Initially, Applicants respectfully submit that Spear is non-analogous prior art that cannot be applied against the claimed invention. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to the particular problem with which

the invention is involved.<sup>6</sup> If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed.<sup>7</sup> The Examiner is also charged to consider "'the reality of the circumstances' ... in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look.<sup>8</sup> With regard to this issue, the Examiner is also referred to M.P.E.P. § 2141.01, entitled "Analogous and Nonanalogous Art."

Whereas the claimed invention is directed to a mail server that detects electronic mail delivery failures in a mail delivery system, Spear is directed to the automation of reducing unsolicited email. Thus, the claimed invention and methodology of Spear are not within the same field of endeavor. Furthermore, the claimed invention is directed to, in part, solving the problem of how to notify a sender as to the failure of an e-mail server to deliver an e-mail to a targeted recipient. The teachings of Spear, however, are not reasonably pertinent to solving this problem. Thus, Spear is non-analogous prior art that cannot be applied against the claimed invention.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 3, 10-11, and 20-21 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Pearson is not viable and, hence, solicit withdrawal thereof.

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<sup>6</sup> In re Clay, 23 USPQ2d 1058 (Fed Cir. 1992).

<sup>7</sup> In re Wood, 202 USPQ 171 (C.C.P.A. 1979).

<sup>8</sup> In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

**CLAIMS 12-14 AND 22-24 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS**

**BASED UPON SPEAR IN VIEW OF GENEROUS ET AL., U.S. PATENT PUBLICATION NO.**

**2002/0120697**

On pages 6 and 7 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Generous to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Applicants respectfully submit that the Examiner's proposed rationale to modify Spear in view of Generous would not have led one having ordinary skill in the art to combine the applied prior art so as to arrive at the claimed invention. The Examiner has failed to set forth a reasonable explanation as to why one having ordinary skill in the art would want to format a detailed notification to a sender of an e-mail when Spear teaches that the "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail.

Moreover, Applicants are entirely unclear as to what purpose would be served to prepare a notification that includes "both a statement of said impairment and an estimate of when normal mail delivery service can resume" or "both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages." In the first instance, the normal mail delivery serve will not resume because the e-mail is considered junk e-mail. In the second instance, the alternative e-mail address would provide no purpose since this alternative e-mail address would now receive the junk e-mail.



Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 12-14 and 22-24 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Generous is not viable and, hence, solicit withdrawal thereof.

**CLAIM 2 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SPEAR IN VIEW OF KATAGIRI ET AL., U.S. PATENT PUBLICATION NO. 2002/0073364, AND GENEROUS**

On pages 7-9 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Katagiri and Generous to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Applicants incorporate herein the arguments previously presented within regard to the rejection of claims 12-14 and 22-24. The Examiner has not put forth a rationale explanation as to why one having ordinary skill in the art would create a notification that includes "an estimated time when said delivery will no longer be impaired; and an alternate e-mail address with which said selected ones of said senders can retransmit said messages to corresponding intended recipients" when the e-mail that is sent is considered to be junk e-mail.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Katagiri and Generous is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the

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Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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